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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,542	03/11/2004	Carol B. Jessup	END920030113US1	7836
36400 7590 03/31/2009 HESLIN ROTHENBERG FARLEY & MESTI P.C. 5 COLUMBIA CIRCLE ALBANY, NY 12203				
EXAMINER				
PATR, JUSTIN				
ART UNIT		PAPER NUMBER		
3623				
MAIL DATE		DELIVERY MODE		
03/31/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action**  
**Before the Filing of an Appeal Brief**

**Application No.**

10/799,542

**Applicant(s)**

JESSUP ET AL.

**Examiner**

JUSTIN M. PATS

**Art Unit**

3623

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 17 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-3, 5, 6, 8-10, 12, 13, 15-17 and 20  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Andre Boyce/  
Primary Examiner, Art Unit 3623

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that Miller does not teach required fields of a question set and that therefore the rejection is improper. Applicant's Remarks, pg. 2. In response, Examiner respectfully disagrees. Each of the questions in Miller, which are for qualification purposes, are considered required fields of a question set. As such, when all the questions are automatically scored and an overall score is produced, this reflects the counting of the number of responses in required fields of a question set (how ever many the applicant responded to) and scoring the question set against a total number of required fields in the question set (seeing how completely and favorably they responded with respect to all qualifying questions and total possible score). The phrase "to product an automatic indication of strength of responses for the question set, the strength of responses indication being an automatic indication of the strength of analysis of the respective root cause of trouble", is considered intended use and is not patentably distinguishable since the prior art is readily capable of performing this function. Regarding Applicant's argument that "product development effort" is functional (Applicant's Remarks, pg. 3), there is nothing positively recited in the claim that is functionally different if applied to product development versus any other kind of employment effort. Thus, the Examiner continues to contend that this purported limitation is nonfunctional at least as currently claimed. Finally, Applicant argues that because of the differences between Whitacre and the claimed invention, there would be no need in Whitacre fore identifying specific project role(s) to provide responses to questions of a question set for a particular root cause of trouble. Applicant's Remarks, pg. 4. In response, it is not necessary that the inventions of the references be physically combinable to render obvious the invention under review. In re Sneed, 710 F.2d 1544, 1550 (Fed. Cir. 1983). In particular, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. In re Keller, 642 F.2d 413, 425. (CCPA 1981). Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. id. A person of ordinary skill in the art is also a person of ordinary creativity, not an automaton. KSR Int'l Co. v. Teleflex inc. , 127 S.Ct. 1727, 1742 (2007). In an obviousness analysis it is not necessary to find precise teachings in the prior art directed to the specific subject matter claimed because inferences and creative steps that a person of ordinary skill in the art would employ can be taken into account. Id. at 1741.